

Applicants: Gabriela Chiosis et al.
U.S. Serial No.: 10/805,624
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REMARKS

Claims 83-89 are pending in the subject application. By this Amendment, applicants have amended claims 83-89. Support for the amendments to claim 83 can be found in the specification at, *inter alia*, page 13, line 26 to page 14, line 1; and Figure 5. Claims 84-89 have been amended to merely correct their dependency. In addition, applicants have amended the Abstract. Applicants maintain that the amendments made hereinabove do not raise any issue of new matter. Accordingly, applicants respectfully request entry of this Amendment. After entry of this Amendment, claims 83-89 will be pending and under examination.

Claim Rejections - 35 U.S.C. §102(b)

In the November 5, 2004 Office Action, the Examiner rejected claim 83 under 35 U.S.C. §102(b) as allegedly anticipated by Anderson et al., *J. Chem. Soc.*, (1974) RN54124-60-6. The Examiner alleged that Anderson et al. discloses a pyrrolidine compound of the structure set forth in claim 83 wherein n is 1 and R is isopropyl.

In response initially, applicants note that none of claims 84-89 are included in this rejection. Thus, in order to expedite prosecution, but without conceding the correctness of the Examiner's statement, applicants have hereinabove amended claim 83 to insert the elements of claims 84 and 85, in the alternative. Thus the rejection of claim 83 as set forth in the November 5, 2004 Office Action is moot.

Applicants additionally point out that as amended claim 83 recites that when n=1, R is R=CH₃ or H. Accordingly, Anderson et al. do not teach all the elements of applicants' amended claim.

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Additionally, the full journal article of Anderson et al. (1974), attached hereto as Exhibit 1 of the Information Disclosure Statement, also does not teach all the elements of applicants' amended claim, and thus this anticipation rejection should be withdrawn.

Claim Rejections - 35 U.S.C. §103

The Examiner rejected claim 83 under 35 U.S.C. §103(a) as allegedly unpatentable over Anderson et al., *J. Chem. Soc.*, (1974) RN54124-60-6. The Examiner alleged that the claimed compound is obvious because it is well established that substitution of methyl for hydrogen on a known compound is not a patentable difference absent unexpected or unobvious results.

In response initially, applicants note that none of claims 84-89 are included in this rejection. Thus, in order to expedite prosecution, but without conceding the correctness of the Examiner's statement, applicants have hereinabove amended claim 83 to insert the elements of claims 84 and 85, in the alternative. Thus the rejection of claim 83 as set forth in the November 5, 2004 Office Action is moot.

Applicants additionally point out that Anderson et al. fail to teach each and every element of claim 83. Applicants note that Anderson et al. only discuss a single compound wherein n is 1 and wherein R is isopropyl. There is no teaching or suggestion in the cited abstract reference, nor in the full journal article, for any group other than isopropyl when n = 1.

Furthermore, the Examiner's statement regarding substitution of a methyl for hydrogen is not germane to the rejection over Anderson et al. because neither a methyl or hydrogen are disclosed as the R group in Anderson et al., in fact an isopropyl group is

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disclosed, and there is no basis to assert that a hydrogen is obvious over a branched chain alkyl (isopropyl). In this regard, applicants note that homologs far removed from adjacent homologs may not be expected to have similar properties (see MPEP 2144.09).

Applicants further note that there is no motivation in the cited reference nor advanced by the Examiner for modifying the non-identical prior art compound (known since at least 1975) absent knowledge of the intended use, i.e. to re-sensitize vancomycin resistant bacteria. Moreover, examination of the full Journal article (Exhibit 1) of the cited abstract makes it clear that the alleged prior art molecule (see structure (III) on page 825 of Exhibit 1) is merely an intermediate in the synthesis of actinonin. There is no suggestion anywhere in the paper to replace the isopropyl group with a hydrogen or a methyl.

Accordingly, applicants maintain that the rejected claim defines an invention not obvious from the cited reference, and therefore respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Conclusion

In view of applicants' amendments and remarks herein, applicants respectfully request that the Examiner reconsider and withdraw the rejections set forth in the November 5, 2004 Office Action.

Information Disclosure Statement

In accordance with their duty of disclosure under 37 C.F.R. § 1.56, applicants direct the Examiner's attention to the following publications which are listed on the attached Form PTO-1449 (Exhibit A):

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- 1) US 6,734,165 B2, Chiosis et al., May 11, 2004; and
- 2) Anderson et al. (1975) Journal of the Chemical Society: Perkins Transactions 1, p825-830. (**Exhibit 1**)

Reference No. 1 listed here is the parent issued patent of the current application. No copy of the reference is required pursuant to 37 C.F.R. §1.98(2)(i)(a) as revised in an Official Gazette Notice published October 12, 2004. A copy of reference No. 2 is attached hereto as **Exhibit 1**. Applicants note that reference No. 1 was referred to by the Examiner in the November 5, 2004 Office action, and that reference no. 2 is the full publication of the Anderson et al., *J. Chem. Soc.*, (1974) RN54124-60-6 cited by the Examiner. Accordingly, applicants understand that the Examiner is aware of these cites, and no fee for this Information Disclosure Statement is enclosed.

Applicants request that the Examiner review the publications and make them of record in the subject application.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee is deemed necessary in connection with this Amendment.
However, if any fee is required, authorization is hereby given to
charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

I hereby certify that this correspondence
is being deposited this date with the
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postage as first class mail in an
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Amendment,
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